## REMARKS

Claims 1 through 60 are pending in the application. Claims 21, 22, 25, 31, 32, 39, 41, through 43, 46, and 51 are amended and claims 52 through 60 are newly added by this Amendment.

Applicant notes that the Examiner objected to the earlier filed Amendment under 37 C.F.R. §1.121(b) as improperly underlining and bracketing the amendments to the specification and the claims. The Examiner's attention is directed to 37 C.F.R. §1.121(a) which specifically states that this rule applies to "amendments in applications, ***other than reissue applications***." Moreover, 37 C.F.R. §1.121(h) expressly states that "***Any*** amendment to description and the claims in reissue application ***must*** be made in accordance with §1.173". It is respectfully submitted that the manner in which Applicant has presented these amendments is in full compliance with 37 C.F.R. §1.173; accordingly, it is respectfully requested that this objection be withdrawn.

37 C.F.R. §1.173 defines the style and format of amendments in reissue applications, not §1.121.

**Rejection of Claims 21-51 Under 35 U.S.C.§231**

In paragraph 2 of the Office action, the Examiner rejected claims 21-51 under 35 U.S.C. §231 "as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." Applicant respectfully traverses this rejection for at least the following reasons.

**First**, nothing in 35 U.S.C. §251 defines either "recapture" or prohibits "recapture".

§251 does however, expressly provides for *broadening* of the scope of the claims of the original patent. Applicant is within the express grant of entitlement to seek broadened claims in this reissue application. Withdrawal of this rejection is therefore required.

**Secondly**, the Examiner supports this rejection by asserting that "the record of the application for the patent shows that the broadening aspect (in the reissue) relates to the subject matter that applicant has previously surrendered during the prosecution of the application." This is incorrect, and the Examiner has not been able to identify any surrender of any subject matter during the prosecution of the parent application. Absent surrender, there is no basis to support the **Examiner's** averment of recapture. Withdrawal of this rejection is therefore required.

**Third**, the Examiner cites "the following limitations [as having] been omitted from the newly presented reissue claims: 'first and second projections' defining 'first and second air bearing surfaces' (claims 21, 31 and 42"; 'arcuate front wall portion' (claims 21 and 31), and 'third and fourth air bearing surfaces' (claim 21)." The Examiner's assertions are factually incorrect on the record. Evidence of this is found in the Examiner's citation of:

> "In the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al. (5,200,868,): (a) an arcuate front wall", (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces."

This is a misrepresentation of the express arguments presented in the paragraph bridging pages 11 and 12 of Applicant's Amendment of 1 December 1998. In that Amendment, Applicant expressly argued that:

> "Claims 1-3, 7, 9-19, and 21-25 are drawn to a negative pressure air bearing slider which includes "*a U-shaped projection ... including an arcuate front wall ... for defining a negative pressure cavity therein.*" The U-shaped projection also has first and second side wall portions "*for defining third and fourth air bearing surfaces.*" Applicant respectfully submits that the claimed slider is not disclosed anywhere in Chapin. For example, Figure 3j cited by the Examiner shows a slider which clearly has neither a U-shaped projection with *an arcuate front wall portion for defining a negative pressure cavity,* nor does it have *third or fourth air bearing surfaces* spaced apart on the slider body. Likewise, none of the numerous other embodiments shown in Chapin disclose a slider according to any of the claims 1-3, 7, 9-19, and 21-25."

The foregoing excerpt from Applicant's 1998 Amendment clearly demonstrate that the Examiner's assertion about "four separate air bearing surfaces" is unfounded. Moreover, the issue is moot about the other two features, both of which are broadly contemplated by the rejected claim 21 through 51 as well as newly added claims 52 through 60. The Examiner's reliance upon the mischaracterization of Applicant's argument is disingenuous and is not helpful to completion of the examination. Withdrawal of the rejection is therefore required.

**Fourth**, Applicant further argued on page 11 of the 1998 Amendment, that

> "Moreover, as can be clearly seen in Fig. 3j cited by the Examiner, Chapin's air bearing slider has the side rails 20 and 22 connected from leading edge to trailing edge without any broken sections. In contrast, in the air bearing slider according to the present claimed invention there are no side rails connected from leading edge to trailing edge. Instead, as shown in Fig. 4 and recited in independent claims 1 and 21, there are the four separate air bearing surface (ABS) platforms 110a, 110b, 110c and 110d distributed at the four edges of the surface. The two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure pocket. This clearly distinguishes the slider of claims 1-3, 7, 9-19, and 21-25 of the present invention from Chapin."

That argument illustrates, as was expressly stated in that argument, that the presence of four separate air bearing surfaces "clearly distinguishes" the claims argued over exemplary art references Chapin '868. That argument does not however, surrender any subject matter disclosed in the original application, and is directed to specific embodiments and implementations of Applicant's invention that are disclosed in the originally filed application. Moreover, that argument was directed, in part, to the novel configuration of Applicant's slider, rather than to the presence of any particular part of Applicant's slider that contributes to Applicant's novel configuration. Furthermore, none of the three elements argued by the Examiner were argued in the second excerpt quoted above. Consequently, the Examiner's reliance upon the 1998 Amendment is improper, inaccurate and misplaced. Accordingly, withdrawal of the rejection is respectfully requested.

In paragraph 3 of the Office action, the Examiner rejected claims 31 through 41 for alleged indefiniteness under the second paragraph of 35 U.S.C. §112. Although Applicant disagrees with the basis for the Examiner's rejection of claim 31, claim 31 has been broadened in scope to delete the phrase "of flight of said slider", thereby rendering the rejection moot.

**Rejection of Claims 21-51 Under 35 U.S.C. §112**

In paragraph 4 of the Office action, the Examiner rejected claims 21 through 51 under the first and second paragraph(s) of 35 U.S.C. §112, based upon the Examiner's averment that "the claimed invention is not described in such full, clear, concise, and exact terms as to enable any

person skill in the art to make and use the same, and/or for filing to particularly pointing out and distinctly claim the subject matter which applicant regards as the invention." Applicant respectfully traverses this rejection for the following reasons:

**First**, the Examiner approved the drawing corrections made during the examination of parent application No. 08/915,342, in Paper No. 8.

**Second**, the Examiner argues that the original disclosure "showed only slider configurations with two separate front air bearing surfaces and a [*sic*, an] U-shaped cross rail with a side extension on each side terminating near the rear edge with an air bearing surface. There is NO disclosure of other [*sic*, another] configuration. These are clearly critical features." Applicant notes that these features are all shown in the drawings and are described in the specification.

**Third**, the Examiner's characterization of Applicant's invention is extremely broad, but fails to satisfy the statute. Under 35 U.S.C. §112, the Congress gave exclusive and sole authorization to the inventor, not to the Examiner, to determine "the subject matter which *the Applicant* regards as his invention." While the Examiner' s thoughts about the novelty disclosed by Applicant in the specification are appreciated, it is the Applicant alone, rather than the Examiner, who has been authorized by the Congress of the United States, to determine the subject matter of his invention. The fact that Applicant seeks broad coverage for his invention by defining combinations of different salient features, has nothing to do with enablement, if those features have been properly disclosed. Both the OG figure, and Applicant's other figures, such as Figures 9 and 10, clearly show structures defined by the newly presented claims, including

newly presented claims 52, 55 and 58, with a "U-shaped air bearing platform defining a negative pressure cavity on said principal surface." The fact that particular implementations of Applicant's inventions as defined by claims 21 through 60 may require additional structure such as an armature, a voice coil motor, a transducer and a sealed container are irrelevant to determinations of novelty. Novelty is determined by the scope of the Applicant's claim relative to the prior art. Consequently, the breadth of Applicant's pending claims provides no basis for rejecting these claims under either the second or the first paragraph of §112; rejections based upon the scope of these claims and their breadth is the office of sections §102 and §103. Accordingly, this rejection is improper, is not authorized under the statute and must be withdrawn.

**Rejection of Claims 21, 28, 29, 31, 32, 39, & 40 Under 35 U.S.C.§102(b)**

In paragraph 6 of the Office action, the Examiner rejected claims 21, 28, 29, 31, 32, 39, and 40 under 35 U.S.C. §102(b) for alleged anticipation by Chapin *et al.* U.S. Patent No. 5,200,868. Applicant respectfully traverses this rejection for the following reasons.

The Examiner relies upon the embodiment of Fig. 3h of Chapin '868. Chapin '868, unlike the embodiments defined by Applicant's pending claims, clearly shows a structure in which apparently both side walls 20, 20', 22 and 22' extend to the rear edge, although the figure has some confusion about the length of channel 30, 32. In contradistinction, both Applicant's rejected claims and Applicant's newly presented claims 52-57 expressly define "at least one of the surface between said first rear termination and said rear edge and the surface between said

second rear termination and said rear edge being in said first plane" (claim 40), which is clearly not the embodiment illustrated by Fig. 3h of Chapin '868.

Moreover, independent claim 21 expressly defines "at least one of said first rear termination and said second rear termination not coinciding with said rear edge." Such a structure is not illustrated by Fig. 3h of Chapin '868. Consequently, there is no anticipation and this rejection must be withdrawn. Such action is respectfully requested.

**Rejection of Claims 20, 30-32 & 41 Under 35 U.S.C.§102(a)**

In paragraph 7 of the Office action, the Examiner rejected claims 21, 30-32, and 41 under 35 U.S.C. §102(a) for alleged anticipation by Nepela *et al.* U.S. Patent No. 5,568,981. Applicant respectfully traversed this rejection for the following reasons.

Figs. 4b, 4c and 5b-5d of Nepala *et al.* '981 cited by the Examiner neglect to show Applicant's "U-shaped air bearing platform defining the negative pressure cavity" as defined by claims 21, 31, 52, 55 and 58. Under the *all-elements* rule of an interpretation of 35 U.S.C. §102(a), if any element of rejected claim is missing from the applied art, there can be no anticipation. Accordingly, Nepela'981 fails to anticipate any of these claims. Withdrawal of the rejection is required.

**Rejection of Claims 22, 23, 30, 33, 34 & 41 Under 35 U.S.C. §103(a)**

In paragraph 9 of the Office action, the Examiner rejected claims 22, 23, 30, 33, 34, and 41 under 35 U.S.C. §103(a) for alleged unpatentability over Chapin '868. Applicant respectfully

traverses this rejection for the following reasons.

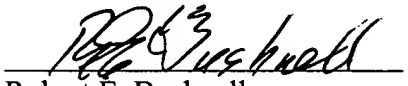
**First**, the Examiner recognizes that Chapin '868 fails to "utilize (A) a gap in the cross rail (re claims 22 and 33), (B) a center location for the gap (re claims 23 and 34), and (C) a rear island for mounting [of] the transducer (re claims 30 and 41)." The Examiner alternatively relies upon Figs. 4a, 4e and 5d to show a "centered gap in the cross rail", but relies upon Fig. 3j to show a separate rear platform for the transducer. The Examiner has neglected however, to show any motivation for making the combinations proposed. Moreover, Fig. 4a does not show a centered gap, but instead shows what Chapin '868 describes as a "circuitous spoiler channel 31 formed in a cross rail 24." Furthermore, the Examiner has not explained how the embodiments of Figs. 4a, 4e and 5d might feasibly be combined with structures that require placement of a transducer on a separate rear platform as shown in Fig. 3j of Chapin '868. Chapin '868 also lacks this critical explanation. The structures are independent and wholly distinct, and are not described by Chapin '868 as having interchangeable air bearing platforms.

**Second**, Figs. 3j, 4a, 4e and 5d of Chapin '868 differ from the structure defined by Applicant's parent claims, by having air bearing surfaces that extend entirely to, and are coterminous with the rear edge of the principal surface of the slider body. This is contrary to the express language of the rejected claims. It is Applicant's combination of these particular structures of the air bearing platform that advantageously endow Applicant's structure to maintain fidelity of disposition during use. The absence of these features from the Examiner's proposed combination is indicia of the non-obviousness of Applicant's structures. Accordingly, this rejection may not be maintained, and should be withdrawn. Such action is respectfully solicited.

A fee of $414.00 is incurred by the addition of three (3) independent claims in excess of 5 and nine (9) total claims in excess of total 51. Also, a fee of $400.00 is incurred by filing a petition for a two month extension of time. Applicant's check in the total amount of $814.00 drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56525RE
Date: 6/18/2
I.D.: REB/kf/mn

## MARKED-UP VERSION OF AMENDMENTS

## IN THE CLAIMS

Please amend claims 21, 22, 25, 31, 32, 39, 41, through 43, 46, and 51 as follows, and add claims 52 through 60, as follows:

21. (Amended) A negative pressure air bearing slider having a negative pressure cavity, comprising:

[a slider having] a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body; and

a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising [a cross rail portion extending generally laterally across said principal surface and first and second side wall portions extending from opposite ends of said cross rail portion] **not more than two separate air bearing platforms each extending** rearwardly toward said rear portion of said principal surface and respectively terminating at a first rear termination and a second rear termination, at least one of said [first and second side wall portions having an arcuate portion] **not more than two separate air bearing platforms including a side wall portion**;

at least one of said first rear termination and said second rear termination [does] not coinciding with said rear edge, and being disposed upstream of said rear edge relative to said rotational direction of said recording medium.

22. (Amended) The negative pressure air bearing slider according to claim 21, further comprising:

a gap disposed within said [cross rail portion] **U-shaped air bearing platform**.

25. (Amended) The negative pressure air bearing slider according to claim 21, further comprising:

a recessed step disposed within said [cross rail portion] **U-shaped air bearing platform**.

31. (Amended) A negative pressure air bearing slider, comprising:

a principal surface defining a first plane tangential to a **first** direction [of flight of said slider];

said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to said **first** direction [of flight of said slider], said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said **first** direction [of flight of said slider]; and

a U-shaped air bearing platform having a plurality of air bearing surfaces **surrounding a negative pressure cavity while** defining a second plane tangential to said **first** direction [of flight of said slider], said U-shaped air bearing platform comprising [first and second side wall portions] **not more than two separate air bearing platforms each** extending from said lead portion rearwardly toward said rear portion and respectively terminating at a first rear termination and a second rear termination, at least one of said [first and second side wall portions forming an arcuate portion] **not more than two separate air bearing platforms including a side wall portion**;

at least one of a surface between said first rear termination and said rear edge and a surface between said second rear termination and said rear edge being in said first plane.

32. (Amended) The negative pressure air bearing slider according to claim 31, wherein said U-shaped air bearing platform further [comprising] **comprises**:

a cross rail portion extending generally laterally across said principal surface.

39. (Amended) The negative pressure air bearing slider according to claim 31, further comprising:

a first front air bearing platform; and

a second front air bearing platform;

said first and said second front air bearing platforms being disposed on opposite ends of said principal surface symmetrically about a longitudinal axis of said slider body, said first and second front air bearing platforms being disposed upstream of said U-shaped air bearing platform relative to said **first** direction [of flight of said slider].

41. (Amended) The negative pressure air bearing slider according to claim [21] **31**, further comprising:

a rear air bearing platform accommodating mounting of a transducer, said rear air bearing platform being spaced downstream of said U-shaped air bearing platform relative to said **first** direction [of flight of said slider], and being centered with respect to a longitudinal axis of said slider body.

42. (Amended) A negative pressure air bearing slider, comprising:

a slider having a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider with a longitudinal axis of said slider extending between said lead portion and said rear portion defining a longitudinal direction of said slider and forming a tangent to said rotational direction, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of said principal surface in said longitudinal direction of said slider; and

a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising [an arcuately shaped cross rail portion extending transversely across said principal surface and first and second side wall portions] **not**

**more than two separate air bearing platforms each** extending from different **and facing spaced-apart** opposite ends of said [cross rail portion] **not more than two separate air bearing platforms** rearwardly toward said rear portion of said principal surface and respectively forming a first air bearing surface terminating said first side wall portion and forming a second air bearing surface terminating said second side wall portion, at least one of said [first and second side wall portions having an arcuate portion] **not more than two separate air bearing platforms including a side wall portion** with said [cross rail portion] **U-shaped platform** comprising an arcuately shaped front wall oriented toward said lead portion.

43. (Amended) The negative pressure air bearing slider according to claim 42, further comprising a gap disposed within said [cross rail portion] **U-shaped platform**.

46. (Amended) The negative pressure air bearing slider according to claim 42, further comprising a recessed step disposed within said [cross rail portion] **U-shaped platform**.

51. (Amended) The negative pressure air bearing slider according to claim 42, further comprising a rear air bearing platform accommodating mounting of a transducer, said rear air bearing platform being spaced downstream of said U-shaped air bearing platform relative to [a] **said** rotational direction of [said] **the** recording medium, and being centered with respect to said longitudinal axis of said slider body.

--52. (New) A negative pressure air bearing slider having a negative pressure cavity, comprising:

a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion separated from a rear portion by a central portion, said lead portion and said central portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear

edge together defining boundaries of longitudinal sides of said principal surface in a longitudinal direction of said slider body; and

a plurality of arcuately shaped arms each having distal ends extending from opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries;

a distal end of at least one of said arms forming a terminal end wholly within said central portion and spaced-apart from said rear portion.

--53. (New) The negative pressure air bearing slider of claim 52, further comprising a cross-rail portion of said platform extending generally laterally across said principal surface and connecting said proximal facing ends.

--54. (New) The negative pressure air bearing slider of claim 52, further comprising said arms adjoining said boundaries.

--55. (New) A negative pressure air bearing slider having a negative pressure cavity, comprising:

a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion separated from a rear portion by a central portion, said lead portion and said central portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of longitudinal sides of said principal surface in a longitudinal direction of said slider body; and

a plurality of arcuately shaped arms each having distal ends extending from opposite ones of said longitudinal sides arcuately inwardly across said principal surface with spaced-apart

proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries;

a distal end of at least one of said arms forming a terminal end wholly within said central portion and spaced-apart from said rear portion.

--56. (New) The negative pressure air bearing slider of claim 55, further comprising a cross-rail portion of said platform extending generally laterally across said principal surface and connecting said proximal facing ends.

--57. (New) The negative pressure air bearing slider of claim 55, further comprising said arms bordering said longitudinal sides.

--58. (New) A negative pressure air bearing slider having a negative pressure cavity, comprising:

a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion separated from a rear portion by a central portion, said lead portion and said central portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of longitudinal edges of said principal surface in a longitudinal direction of said slider body, said central portion being formed by opposite longitudinal sides separated by a longitudinal center and bounded by said longitudinal edges; and

a plurality of arcuately shaped arms each having distal ends extending from opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries;

at least one of said distal ends forming a terminal end wholly within said central portion and spaced-apart from said rear portion.

--59. (New) The negative pressure air bearing slider of claim 58, further comprising a cross-rail portion of said platform extending generally laterally across said principal surface and connecting said proximal facing ends.

--60. (New) The negative pressure air bearing slider of claim 58, further comprising said arms adjoining said longitudinal edges.